

6, line 66 through column 7, line 2 of Houvener) and a “digital image displayed on the display means” (column 4, lines 9-10 of Houvener) to the recited “projection unit.” Claim 1, however, recites “a media player for reading digital data stored on said data storage medium; and a projection unit for displaying said digital data . . .” Thus, the Examiner’s “projection unit” does not display “said digital data” read by the “media player.” The Examiner’s inconsistent usage of the terms recited by Claim 1, based on vague and inexact citations of the prior art, cannot be held to read the prior art onto the limitations recited by the claims. Having failed to read the elements and teachings of the prior art onto the specific elements and limitations of Claim 1, the Examiner has failed to provide a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

The applicant respectfully submits the Examiner has failed to present a prima facie case of obviousness because the Examiner has not presented any evidence of any teaching in the prior art that would lead one of ordinary skill in the art to make the substantial modifications to Houvener and Hurta required to make a prima facie case of obviousness under 35 U.S.C. § 103. The Examiner stated, “Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve the secure digital image of Houvener by incorporating an interrogator and a transponder as taught by Hurta because it would provide the secure digital image of Houvener with the advantage of increase [sic] privacy and flexibility with respect to identity verification of individual users that includes other pertinent data (see., Hurta, col 7, lines 57-64).” The passage cited by the Examiner states, “This embodiment further has the advantage of increased privacy and flexibility with respect to ‘money on tag’ systems in which the money alone is stored directly on the tags. In such prior systems, special agents are required with special machines to input money into the transponder 14. In this embodiment, the transponder 14 is loaded with money from the smartcard 66, which may have money placed in it through automatic machines similar to automatic teller machines (ATM).” The applicant respectfully submits that this passage of Hurta cannot reasonably form a suggestion to one of ordinary skill in the art, at the time the invention was made and without the use of hindsight, to implement the extensive and ambiguous modifications required by the Examiner to the teachings of Houvener. Having failed to present any evidence of any teaching in the prior art that would

lead one of ordinary skill in the art to make the substantial modifications to Houvener and Hurta required to make a prima facie case of obviousness under 35 U.S.C. § 103, the Examiner has failed to provide a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Claims 2-4 and 6-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Houvener in view of Hurta. The applicant respectfully disagrees. Claims 2-4 and 6-13 depend from Claim 1 and should be deemed allowable for that reason and on their own merits.

Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Houvener in view of Hurta. The applicant respectfully disagrees. The applicant respectfully submits the Examiner has failed to present a prima facie case of obviousness because the Examiner has not read the elements and teachings of the prior art onto the specific elements and limitations of Claim 14. Having failed to read the elements and teachings of the prior art onto the specific elements and limitations of Claim 14, the Examiner has failed to provide a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Claims 15-17 and 19-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Houvener in view of Hurta. The applicant respectfully disagrees. Claims 15-17 and 19-24 depend from Claim 14 and should be deemed allowable for that reason and on their own merits.

Claims 5 and 18 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Houvener in view of Hurta, in further view of U.S. Patent No. 5,469,363 to Saliga. The applicant respectfully disagrees.

The applicant respectfully submits the Examiner has failed to present a prima facie case of obviousness because the Examiner has not read the elements and teachings of the prior art onto the specific elements and limitations of Claims 5 and 18. The Examiner stated, "Saliga discloses an electronic tag with source certification 52 that is potted or sealed into a tamper-proof enclosure (see., abstract, col 3, lines 44-58)." The relevant portion of the passage cited by the Examiner states, "the tag circuitry 52 is potted or sealed into a tamper-proof enclosure 56 to complete the manufacturing process. Once the tag 10 is sealed, the inductive coupling circuit 12 is the only means by which data can be loaded into or read from it." In contrast, Claims 5 and 18 each recite, "a media jukebox for opening a tamper-proof cartridge containing said data storage

medium, and for accessing said data storage medium.” Having failed to read the elements and teachings of the prior art onto the specific elements and limitations of Claims 5 and 18, the Examiner has failed to provide a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Claim 25 was rejected under 35 U.S.C. §102(e) as being anticipated by Houvener. The applicant respectfully disagrees. MPEP § 2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053, (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the . . . claim.”

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Contrary to the Examiner’s assertion, “an identification system module . . . containing an authorization code describing which media players are authorized to read digital data from said digital storage medium” is not disclosed by Houvener. The Examiner’s rejection, therefore, is unsupported by the prior art and should be withdrawn.

Claims 26-30 were rejected under 35 U.S.C. §102(e) as being anticipated by Houvener. The applicant respectfully disagrees. Claims 26-30 depend from Claim 25 and should be deemed allowable for that reason and on their own merits. The Examiner has not attempted to read the prior art onto the additional limitations of Claims 26-30. The Examiner’s rejection, therefore, is unsupported by the prior art and should be withdrawn.

Claims 31 and 38 were rejected under 35 U.S.C. §102(e) as being anticipated by Houvener. The applicant respectfully disagrees. The Examiner has failed to assert any of the elements of Claims 31 and 38 are disclosed by Houvener. The Examiner’s rejection, therefore, is unsupported by the prior art and should be withdrawn.

Claims 32-37 and 39-42 were rejected under 35 U.S.C. §102(e) as being anticipated by Houvener. The applicant respectfully disagrees. Claims 32-37 and 39-42 depend from Claims

31 and 38 and should be deemed allowable for that reason on their own merits. The Examiner has not attempted to read the prior art onto the additional limitations of Claims 32-37 and 39-42. The Examiner's rejection, therefore, is unsupported by the prior art and should be withdrawn.

In view of the remarks presented herewith, it is believed that the claims currently in the application, Claims 1-42, accord with the requirements of 35 U.S.C. §112 and are allowable over the prior art of record. Therefore, it is urged that Claims 1-42 are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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